

### REMARKS

Please consider the present Remarks and accompanying declaration of Tomo Takayama. The present amendment is in response to the Office Action mailed on October 31 2006. This is pointed out because the Office Action states that it is in response to a communication filed on June 29, 2006. This is in apparent inadvertent error because the Office Action is clearly responsive to the communication that applicant filed on September 6, 2006.

The present amendment places the claims in better form and principally directs the claims to preferred embodiments

The presently amended claims recite "serine, glycine, taurine, beta-alanine, gamma-amino butyric acid, histidine, proline, L-ornithine, lysine and a nutritionally acceptable salt of any of said compounds" for use in the method of preparing noodles or other food for the purpose and with the result that the amount of acrylamide formed during the heating step of the food is reduced relative to the amount that would be formed without adding the cited ingredients. Recitation of the compounds "serine, glycine, taurine, beta-alanine, gamma-amino butyric acid, histidine, proline, L-ornithine, lysine" or their salts is amply supported in the specification. [serine (page 4), glycine (page 4), taurine (page 4), beta-alanine (page 37), gamma-aminobutyric acid (page 9), histidine (page 4), proline (page 4), ornithine (page 9) lysine (page 9) and numerous examples in the specification.

Dependent claims are drawn to the use of the presently most preferred compounds in the methods of the invention, namely glycine, lysine and taurine or a salt of these most preferred embodiments.

Newly added claims are drawn to the preferred embodiment of frying noodles wherein a dough is first shaped into the form of noodles, the noodles are steamed, after steaming a solution

of a compound claimed in the present claims is applied to the noodles and thereafter the noodles are fried. Support for these claims is found in the original specification. See page 18 applying in the form of "showering, spraying or coating" and Examples 2 and 4. In example 2 a seasoning solution containing glycine is sprayed on the steamed noodles; in Example 4 a seasoning solution of lysine hydrochloride is sprayed on the steamed noodles.

The subject matter of the instant claims is neither anticipated nor rendered obvious by the cited references and "inherency" does not bar the patentability of the present process claims

Under 35 U.S.C. §§ 100 and 101, new uses of a known process are patentable, except where the purpose of the new use is directed towards the same purpose as the known process. 35 U.S.C. §§ 100, 101; *Abbott Labs. v. Baxter Pharm. Prods., Inc.*, 471 F.3d 1363, 1368-69, 80 U.S.P.Q. 2d 1860 (Fed. Cir. 2006) (citing *Bristol-Meyers Squibb*, 245 F.3d 1368, 1376, 58 U.S.P.Q. 2d 1508 (Fed. Cir. 2001)). In *Abbott Labs.* the Federal Circuit reaffirmed its statement in *Bristol-Meyers Squibb* that new uses of a known process were indeed patentable if the purpose of the new use differed from the purpose of the known process. *Abbott Labs.*, 471 F.3d at 1368-69.

None of the three cited references mention in any way that the purpose of adding certain amino acids or their salts to noodles or other before frying or heating would reduce the formation of acrylamide during the frying or other heating process. The present claims were amended to make it even more explicit that the claimed process is practiced for the purpose of obtaining fried noodles or other food items having a reduced acrylamide content.

In contrast to the present invention and claims, the stated purpose of the *Teh et al.* (United States Patent Number 6,482,461) reference is to prepare preheated flavor ingredients and to provide fried noodles of savory flavor.

The stated purpose of the *Jaeggi* (United States Patent No. 4,218,487) reference is to make a synthetic flavor composition. The synthetic flavor composition of this reference is not a food by itself. Instead it is to be added to food in a manner which is not clearly revealed in the reference. (For example, Example 1 of *Jaeggi* refers to obtaining “pronounced meat flavor”, Example 2 “roast potato”, Example 3 baked hazelnut flavor, etc.) Thus, heating food items which incorporate the “synthetic flavors” is not taught in this reference, and may not be the manner in which the “synthetic flavors” are used. For example they could be added to food that has already been prepared by heating.

The stated purpose of the *Yajima et al.* (United States Patent No. 6,824,801) reference is to obtain a food preservative or food that has “excellent preservability” (Column 1 of the reference “Technical Field”). The process includes the addition of 1,5-D-anhydrofructose. When anhydrofructose is added as suggested by *Yajima et al.* then the amount of acrylamide formed in deep fat fried noodles is actually increased relative to the acrylamide formed in the same process without the 1,5-D-anhydrofructose. See the attached Takayama Declaration.

Applicant respectfully submits that their stated purpose is an important element of the present claims. The law is clear that

“‘[T]he dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior art reference’s teaching that every claim [limitation] was disclosed in that reference.’ *Dayco Prods. Inc. v. Total Containment, Inc.*, F.3d 1358, 1368 (Fed. Cir. 2003)

In the present case it should be clear that no inference whatsoever could or would be drawn by one skilled in the art regarding any of the references’ process’ ability to reduce acrylamide formation. Claim 54 is of special interest and example in this regard for the error in the holding of anticipation or obviousness, because none of the references, standing alone or in

combination, describe or suggest a method of making instant fried noodles having an "acrylamide content approximately less than 60 ppb"

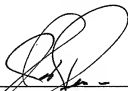
Nor would a person of ordinary skill in the art receive any suggestion from any of the cited references or combinations thereof that addition of the claimed amino acids before frying or heating will reduce the formation of acrylamide. Moreover, using the *Yajima et al.* process, that is including 1,5-D-anhydrofructose before frying the noodles increases the amount of acrylamide formed.

The instant specification teaches that a "balance" is needed regarding the amount of additive and the desired taste, color (and other qualities) of the food to be obtained. (See page 17, first paragraph). Mr. Tomo Takayama is a food chemist working for Toyo Suisan Kaisha Ltd. (the parent company of Maruchan Inc.) and is also a co-inventor of the present application. In addition to repeating the *Yajima et al.* process Mr. Takayama also performed experiments using several amino acids and found that when the taste, color and consistency of the resulting product (fried noodles) is considered then some of the amino acids provide less than completely satisfactory and less commercially acceptable product. The preferred embodiments recited in the present claims are amino acids (or their salts) which significantly reduce the amount of acrylamide formed during the frying process and still provide good commercially acceptable product as far as taste, color and consistency are concerned. In light of this, the selection of the amino acids in the claimed process represents an unobvious selection.

In the event the Examiner is of the opinion that a telephone conference with the undersigned attorney would materially facilitate the final disposition of this case, she is respectfully requested to telephone the undersigned attorney at the below listed telephone number.

Very truly yours,

**SNELL & WILMER L.L.P.**

A handwritten signature in black ink, appearing to be 'J. Price', written over a horizontal line.

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